

REMARKS/ARGUMENTS

Applicants have carefully considered the Office Action dated January 3, 2003 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Claims 13-17 and 19-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,718, Spector, in view of U.S. Patent 5,555,496, Tackbary et al., "Tackbary." Claim 13 has been amended and now specifically recites a data structure comprising "data associating the card with a gift" (Claim 13, line 5). Neither Spector nor Tackbary disclose such limitation. Spector specifically discloses a technique for generating greeting cards with a gift certificate, not a gift. In fact, Spector expressly states that the gift certificate is a more desirable an alternative to a gift (Spector, Col. 2, lines 2-5, Abstract). Conversely, the present invention provides a method and system for enabling users to log on remotely over a computer network to a server containing a compilation of cards. Using a GUI, the user can personalize the card(s) through various modifications, e.g., changes in the graphics, font color, font size, font style, attachment of scanned information, such as a signature or a photo. The card, including the changes thereto, can be viewed in What You See Is What You Get (WYSIWYG) format by the user so the user can see what the modified card will look like prior to acceptance thereof. The card can be sent to a mailing address, as defined by the user, in conjunction with a gift or other item associated with the card. Accordingly the present invention allows a personalized card to match with a gift and sent together with the gift to the designated recipient. None of the cited references discloses the ability to 1) modify the card and see the modifications superimposed with the database copy of the card in WYSIWYG format, or 2) to allow the card to be matched with a gift and shipped together.

Claims 14-16 have been amended, as necessitated by the amendments to claim 13, to provide proper antecedent basis for all terms contained therein. Claims 14-16 include all the limitations of claim 13 and are likewise believed allowable over the cited references for at least the same reasons as claim 13, as well as on their own respective merits.

In the setting forth the rejection of claim 17, the Examiner has admitted that Spector fails to disclose data defining the relationship of the graphical information to the

card image. Instead, the Examiner is relying on Tackbary to disclosing such teachings. However, after reviewing the sections of Tackbary cited by the Examiner (Col. 10, lines 43-51), the section of Tackbary cited by the Examiner discloses nothing more than the presentation of a card image from a database prior to selection by a user. Conversely, the data structure recited by claim 17 is useful for storing information during and after modification or customization to a selected card. In the present invention, a data structure, such as that illustrated in Figures 4-5, enables customizations, such as text, scanned files, and other graphical information to be placed anywhere within the image of a card, as illustrated by the samples the Figures 6C-6D of the subject specification. The claimed data structure of the present invention enables the nature of the graphical information to be stored along with data defining the relationship of the graphical information to the card image, e.g. user selected position coordinates of the graphical information on the card image. The Examiner has failed to indicate where Tackbary discloses the data structure comprising the *Of one of the data identifying modifications to the identified card template, the identifying data comprising graphical information and data defining the relationship of the graphical information to the card image.* Accordingly, Applicants respectfully assert that claim 17, as filed, by the Examiner's own admission, is allowable over the combination of Spector with Tackbary.

Claim 18 has been amended similar to claim 13 and to conform its language to that recited in the Summary of the Invention section. Specifically, claim 18 now recites a method including "authorizing delivery of the card to the destination address in conjunction with_a gift with which the card is associated" (claim 18, lines 10-114). In setting forth the rejection of claim 18 the Examiner has admitted that Spector does not teach authorizing delivery of the card to the destination address in conjunction with an electronic-commerce transaction with which the card is associated. Instead, the Examiner is relying on Tackbary for such teaching. However, Tackbary does not disclose the delivery of a card with a gift come as now recited by claim 18. In light of the foregoing amendment to claim 18, claim 18 is believed allowable over Spector, Tackbary, whether considered singularly or in alleged combinations, as well as for at least the same reasons as claims 13.

Claim 19 has been amended similar to claim 13. Specifically, claim 19 now recites a computer system connectable to a computer network comprising "program logic configured to receive data identifying a gift associated with the card" and "program

logic configured to transmit any of the card identifier, data modifying the card, and identifier to a remote location over a computer network " (Claim 19, lines 10-14). Applicants respectfully assert that the Examiner has failed to indicate where either Spector or Tackbary discloses such limitations for the reasons stated above with reference to claim 13. Accordingly, Applicants respectfully assert that claim 19 as amended, is allowable over the combination of Spector with Tackbary for at least the same reasons as claim 13, as well as its own respective merits. Claims 20-22 have been canceled without prejudice. Claims 23-24 include all the limitations of claim 19 and are likewise believed allowable over the cited references for at least the same reasons as claim 19, as well as on their own respective merits.

Claims 1-12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,718, Spector, in view of U.S. Patent 5,555,496, Tackbary et al., "Tackbary" and further in view of U.S. Patent 6,052,514 Gill et al., hereafter "Gill" and U.S. Patent No. 6,038,573, Parks.

Notwithstanding the attempted combination of Spector with Tackbary, the Examiner has admitted that Spector in combination with Tackbary do not explicitly disclose received modifications in WYSIWYG format. Instead the Examiner is relying on Gill and Parks to supplying such teachings alleging that the concept and advantages of using received modifications in WYSIWYG format are well known in the art as evidenced by Gill and Parks (Gill Col. 3, lines 33-67 and Col. 4 lines 1-57; Parks Col. 2, lines 23-36) because it provides the users with a greater certainty concerning the accuracy of relevant information for each publication item (Gill Col. 4 lines 40-49). The Examiner further states that one of ordinary skill in the art at the time of the invention would have combined Gill and Parks features to Spector's and Tackbary's because it would have provided to the users in Spector and Tackbary with an accurate view and format of the information intended to be sent to another destination.

Applicants respectfully traverse the rejection of claims 1-12 and 18 under 35 U.S.C. §103(a) on the grounds that the Examiner has failed to create a *prima facie* case of obviousness. In accordance with MPEP §2143.03, to establish a *prima facie* case of obviousness 1) the prior art reference (or references when combined) must teach or suggest *all* of the claim limitations; 2) there must be some suggestion or motivation to modify a reference or combine references; and 3) there must be a reasonable expectation of success.

The Examiner has failed to disclose where in any of Spector, Tackbary, Gill and Parks there is a some teaching, suggestion or motivation to combine the respective teachings of all four references, as required for a *prima facie* case of obviousness. Alleging that Spector can be combined with Tackbary, and that Gill and Parks can be combined with the combination of Spector and Tackbary, is not the same as providing a teaching, suggestion or motivation that the respective teachings of Spector, Tackbary, Gill and Parks be combined in a manner in which there must be a reasonable expectation of success. The Examiner has failed to show where, in anyone of the combined references, that there exists a teaching, suggestion or motivation to combine the respective teachings of *all four references*.

The respective sections of Gill and Parks cited by the Examiner relate to formatting of ASCII text based documents with no card image, as in the subject invention. The Examiner has admitted that Spector fails to disclose data defining the relationship of the graphical information to the card image. For the reasons stated previously herein, Tackbary also does not provide such a teaching. The Gill and Parks references also do not provide a teaching of presenting graphical information in relation to a card image.

Further, the Examiner's mere statements:

"However, the concept and advantages of using received modifications in WYSIWYG format are well known in the art as evidenced by Gill and Parks because it provides the users with a greater certainty concerning the accuracy of relevant information for each publication item "

"One of ordinary skill in the art at the time of the invention would have combined Gill and Parks features to Spector's and Tackbary 's because it would have provided to the users in Spector and Tackbary 's with an accurate view and format of the information intended to be sent to another destination."

do not establish where in Gill or Parks there is a suggestion or motivation that their respective disclosures be combined with each other or with the alleged combination of Spector and Tackbary, as required. Accordingly, applicants respectfully traverse the on the grounds that the Examiner has failed to provide some suggestion or motivation to modify a reference or combine references.

Further, even if the Spector, Tackbary, Gill and Parks references were combined as suggested by the Examiner, the combination still does not teach or suggest the invention as currently claimed. Method claim 1 distinctly claims the limitation of "maintaining a network accessible compilation cards" (claim 1, line 2). Spector does not disclose a network accessible compilation of cards. Specifically, greeting card software 15 is part of the computer/printer terminal, as illustrated in Fig. 1 of Spector. Although the computer-printer terminal of Spector is linked to the Internet 10 via modem 11, there is no disclosure or teaching in Spector that a process outside of the computer-printer terminal may access the greeting card software 15 via Internet 10 and modem 11. Given the limited description of the computer-printer terminal in Spector, and specifically the greeting card software 15, the Examiner has not demonstrated that software 15 does anything other than simply reside in the memory of the computer-printer terminal and interact with "computer 12" through either a peripheral connection or an internal bus. In Tackbary, the card database 110 is part of software 80 of local computer system 5 (Tackbary, Fig 1) . As such, the compilation of cards in Tackbary is also not network accessible. Accordingly, neither Spector nor Tackbary disclose maintaining a network accessible compilation of cards as disclosed in the present invention and as recited in claim 1.

In light of the above, Applicants respectfully assert that claim 1 is patentable over Spector, Tackbary, Gill and Parks, whether considered singularly or in attempted combinations. Claims 2-11 include all the limitations of claim 1 and are believed allowable over Spector, Tackbary, Gill and Parks for at least the same reasons as claim 1, as well as on their own respective merits.

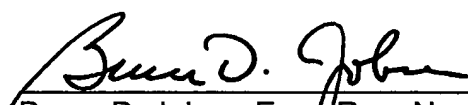
Computer program product claim 12 includes limitations similar to claim 1 and specifically recites "program code for maintaining a network accessible compilation of cards " (claim 12, line 4). Accordingly, claim 12 is believed allowable over Spector, Tackbary, Gill and Parks, whether considered singularly or in attempted combinations, for at least the same reasons as claims 1, as well as for its own respective merits.

In addition, Applicant incorporates by reference the traversals to the combination of Spector and Tackbary, as set forth in Applicant's prior responses, and to the extent relevant, Applicant further respectfully reasserts all of the remarks and traversals set forth in the last response to the extent still relevant to the outstanding rejections.

The amendments to the claims as set forth herein have been offered to advance this application to issue. None of the amendments made herein should be construed as an admission that the subject matter of the claims, as originally filed, is anticipated by or made obvious in light of any art of record whether considered singularly or in combinations. Applicant expressly reserves the right to pursue the originally filed claims in another co-pending application without being prejudiced by any amendments, including cancellation of claims, made herein.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. 02-3038.

Respectfully submitted,



Date:

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